

intervening claims, and Claims 1 and 4 have been rejected. The basis for rejection of Claims 1 and 4 remains the same as set forth in the previous Office Action. Applicants respectfully request favorable reconsideration of the subject application, particularly in view of the following remarks.

As the basis for rejection of Claims 1 and 4 remains the same as set forth in the previous Office Action, Applicants' arguments as set forth in Applicants' response filed on 09 May 2005 are still applicable and, thus, will not be repeated in their entirety.

The invention claimed by Applicants is a method and apparatus for determining release rates of volatile contaminants from soils. The apparatus comprises a transparent reactor vessel comprising *sealable* means for introducing at least one volatile liquid sample into the transparent reactor vessel, at least one sorbent contained within the transparent reactor vessel, and *separation means for preventing direct contact between the at least one sorbent and any soil/NAPL complex present in the transparent reactor vessel*. The separation means permit passage of solvent soluble constituents of the volatile liquid sample to be sorbed by the at least one sorbent. As described beginning at Page 6, line 21 of the specification of the subject application, the apparatus *as claimed* enables contacting soil with a liquid so as to maintain *a gas headspace volume equivalent to virtually zero percent of the total*

*contents of the reactor vessel* and for employing a sorptive resin for measurement of the contaminant releases from the soil into the liquid phase, e.g. water, of the reactor vessel without direct contact of the resin with the soil solids.

Claims 1 and 4 have been rejected under 35 U.S.C. 102(b) as being anticipated by Davison et al., U.S. Patent 5,922,974 (hereinafter “the Davison et al. patent”). This rejection is respectfully traversed. 35 U.S.C. 102(b) states :

“A person shall be entitled to a patent unless-  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.”

Accordingly, in order for a reference to anticipate a claimed invention, the reference must teach *each and every element* of the claimed invention. In the case where the claimed invention is an apparatus, as in the instant case, the reference must teach each *structural* element of the claimed apparatus. In addition, although the prior art reference need not teach the manner of use of the claimed apparatus, it is well established that *the apparatus of the prior art reference must be capable of performing the intended use of the claimed invention*, a fact acknowledged by the Examiner. That is, the apparatus of the prior art must be capable of performing the method of Applicants’ claimed invention.

The issue at hand in the instant application is the meaning or interpretation to be ascribed to the element *sealable means* claimed by Applicant. In

responding to Applicants' previously submitted response in which Applicants' argued that this element must be given an interpretation consistent with the specification, the Examiner argued that, although the PTO is obligated to give a disputed claim its broadest reasonable interpretation, taking into account any enlightenment by way of definitions or otherwise found in the specification, Applicants cannot read limitations set forth in the description into the claims for the purpose of avoiding the art.

*Applicants respectfully urge, however, that far from reading a limitation set forth in the description into the claims as asserted by the Examiner, Applicants are merely asserting the possession of a structural feature of the sealable means of Applicants' claimed invention which affords the intended use of the apparatus and without which structural feature the apparatus would be unable to perform its intended use.*

To use the claimed invention for its intended purpose, which is to determine the release rates of contaminants from soils, requires that the apparatus maintain a gas headspace volume equivalent to virtually zero percent of the total contents of the apparatus (Page 6, line 21 to Page 7, line 4, Page 7, lines 12-18 of the specification, and Claim 7). This is accomplished by the sealable means of the claimed apparatus which precludes the exchange of fluids, including gases, between the interior and exterior of the apparatus. It, therefore, follows that the sealable means

of the invention claimed by Applicants must include a *structural feature* which precludes the exchange of fluids between the interior and the exterior of the apparatus.

*The apparatus of the Davison et al. patent is not capable of performing the intended use of Applicants' claimed invention* because the seals 30, 31 identified by the Examiner as corresponding to the sealable means of Applicants' claimed invention are gas permeable (Col. 2, lines 60-63) and, thus, are *not capable of enabling the maintenance of a virtually zero percent gas headspace volume* as is required for the apparatus of Applicants' claimed invention to perform its intended use. As stated by the Examiner, if the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the prior art structure *is not capable* of performing the intended use because the sealable means thereof does not enable the maintenance of a virtually zero percent gas headspace as does the sealable means of Applicants' claimed invention. It is, thus, clear that the sealable means of the Davison et al. patent is *structurally different* from the sealable means of the apparatus of Applicants' claimed invention. Accordingly, given the fact that the Davison et al. patent does not teach or suggest an apparatus having a sealable means as claimed by Applicants, *which sealable means includes a structural feature which enables the maintenance of a virtually zero percent gas headspace volume in the apparatus*, and given the fact that without such a sealable means as claimed by

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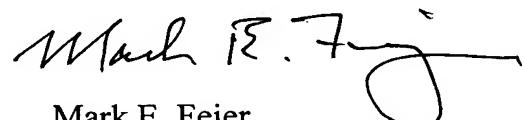
Applicants the apparatus of the Davison et al. patent is not capable of performing the intended use of the apparatus of the invention claimed by Applicants, Applicants respectfully urge that the Davison et al. patent does not anticipate the invention claimed by Applicants in the manner required by 35 U.S.C. 102(b).

### **Conclusion**

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed in this response, Applicants urge the Examiner to contact the undersigned.

Applicants sincerely believe that this patent application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,



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